



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,833	09/11/2003	Thomas J. Kennedy III	D-5907-C1	5956

24492 7590 02/11/2005

THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED
SUBSIDIARY OF CALLAWAY GOLF COMPANY
2180 RUTHERFORD ROAD
LEGAL DEPT
CARLSBAD, CA 92008-7328

EXAMINER

BUTTNER, DAVID J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,833	KENNEDY ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/03</u> | 6) <input type="checkbox"/> Other: ____ |

Applicant claims 9-837403 is a child case of 9-523563, 9-241186 and 8-763070. This is inaccurate. Claims of priority to these applications must be deleted from the specification. Note that these three applications lack basis for aromatic polyamides. The status of 9-837403 must be updated in the specification.

The IDS of 11/26/03 did not include copies of the foreign references. The lined out references are not present in the parent file (9-837403) and were not considered.

Claims 12 and 13 are missing. The examiner assumes these two claims are intended to be cancelled. The next response must include a listing of all claims indicating these two are cancelled.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The isophthalic acid of claims 1, 18, 19, 29 and 30 do not qualify as phthalic acid. "phthalic acid polyamide" must be construed as requiring units from phthalic acid. Any other interpretation would be repugnant to the ordinary meaning. Note that applicant (page 6 of spec.) clearly distinguishes between phthalic, isophthalic and terephthalic acid. If applicant intends the claims to be limited to polyamides derived from phthalic acid or isophthalic acid, then "phthalic acid polyamide" should be replaced by "polyamide".

Claims 1, 18, 29 and 31 call for "at least one of phthalic acid and isophthalic acid". This requires both to be present. Is this intended? Claim 19 is indicative that the two are intended to be alternatives.

Art Unit: 1712

Claim 30's "acrylate" is not understood. The specification does not add acrylate monomer to polyamide and ionomer. It appears that ethylene/acrylate copolymers – not acrylates are added.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the inclusion of an acrylate (presumably monomeric) to blends of polyamide and ionomer.

Claims 1-7,11,14,15,16 and 29-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan '862 Patent.

Rajagopalan suggests two or three piece golf balls (abstract). At least one of the layers is a sulfonated or phosphonated ionomer optionally blended with a polymer such as polyamide (col. 29, lines 51-53). The polyamide can be based on isophthalic acid (col. 30, line 55). If the possible choices of blending partner are too numerous to be considered anticipatory, it is at least prima facie obvious to employ any blending partner named in the reference.

Art Unit: 1712

Claims 1-7,11, 15 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J10305116 Patent.

The reference blends ionomer and polyetheramide for use as golf ball covers. The polyetheramide can contain isophthalamide units (paragraph 8).

Presumably the same interactions between the ionomer and polyamide will be present in the reference as is for applicant (page 8, lines 5-17).

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Rajagopalan '862 Patent or J 10305116 in view of Sullivan '304.

The primary references do not report compression or COR values for their balls. However, these values are conventional as shown by Sullivan's table (col. 23). It would have been obvious to ensure the balls of primary references have compression and COR values within normal parameters.

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melanson '140 Patent.

The reference clearly meets the claims (see claim 1 of patent). Presumably, Melanson's golf ball would have the same COR and compression as required by applicant's claims 8-10 because the same materials are used.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1712

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 14-31 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6384140. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application also claims blends of ionomer with polyphthalamide. The claims are broader in the sense that ethylene/acrylate is not required to be present in all claims as in the patent. Furthermore, the patent allows the polyamide to be based on terephthalic acid.

WO 98/40127, J62022841 and Bissonnette'535 suggest golf balls of polyamides based on terephthalic acid, but not isophthalic or phthalic acid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1712

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David. Buttner
February 7, 2005

A handwritten signature in black ink that reads "David Buttner". The signature is written in a cursive style with a large, stylized "D" and "B".